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In re Application of:
Watts, Lee et al.
Serial No. 10/775,033
Filed: February 09, 2004
Docket: 67341-1985; 03MRA0135
Title: EXHAUST PIPE VALVE

DECISION ON PETITION

This is a decision on the petition filed on July 11, 2007 requesting that the holding of abandonment be withdrawn. As such, this is being treated as a petition under 37 CFR § 1.181. It appears petitioner is further requesting, if the application is not withdrawn from abandonment, that the petition be treated as a petition to revive for either unavoidable delay under 37 CFR § 1.137 (a), or failing that for unintentional delay under 37 CFR § 1.137(b).

Initially, it is pointed out that the petition requests two different forms of relief. This is impermissible under 37 CFR § 1.4(c). This decision will only address the issues under 37 CFR § 1.181 since the resulting decision affects whether applicant should separately petition for revival under 37 CFR § 1.137 or request reconsideration under 37 CFR § 1.181. No fee is required for a petition under 37 CFR § 1.181.

The petition is granted.

Background

Applicants filed a first appeal brief on September 08, 2006. A Notice of Non-Compliant Appeal Brief was mailed December 01, 2006. The Notice stated that the brief does not contain a statement of the status of all claims and that the brief does not present an argument under a separate heading for each ground of rejection. In particular, the examiner pointed out that the status of claim 2 was missing and that a separate subheading was missing for each claim separately argued. Applicants responded with a second brief providing the status of claim 2. However, the appeal was dismissed in a letter mailed June 21, 2007. The appeal was dismissed because the new brief failed to provide subheadings for each claim argued separately. Since no claims were allowed, the application was held abandoned in the same letter. Applicants petition by way of their legal representative that the amended brief is in compliance with the regulations

or that applicants should have been afforded a chance to correct any deficiency since the attempt to correct the original brief by way of the amended brief was a bona fide attempt to comply.

Discussion and Decision

As an operation of 37 CFR § 41.37(d), an appeal will be dismissed if an amended brief does not overcome all the reasons for non-compliance within the set time period. Abandonment follows if there are no allowed claims and no time remains by way of requests for extensions of time.

A review of the amended brief indicates that the examiner's observations are indeed correct that individually argued claims in a grouping are not provided under a separate subheading. In particular, claims 6 and 14 are separately argued under heading B; claims 7, 10, 17, and 18 are separately argued under heading C; claims 19, 20, 21, and 22 are separately argued under heading D; and claims 23, 24, and 25 are separately argued under heading E; i.e., there are no subheadings under each of the respective headings B, C, D, and E identifying each of these respective, separately argued claims. It is noted that the separate arguments to each of these separate claims is clear and understood as to what is intended and for each claim without the subheadings.

37 CFR § 41.37(c)(1)(vii) states:

(vii) Argument. The contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown. Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. [Emphasis added.]


It is clear from the wording that headings are required for each ground of rejection. This is not an issue. The original and amended briefs clearly comply with this requirement. It could be an issue for the subheadings since, as noted above, they are missing. However, from the wording of the regulation, subheadings are not an absolute requirement. The phrase "should be" provides some latitude compared with the phrase "must". Since subheadings are not needed to

differentiate arguments to each separately argued claim, omission of the subheadings is not considered essential to the understanding of the arguments. In view thereof, a requirement for these subheadings is not considered mandatory in this specific write-up of the brief(s) in the present application. In view thereof, the relief sought is granted. The letter of June 21, 2007 dismissing the appeal and abandoning the application is hereby vacated and application withdrawn from its abandoned status. In view thereof, the filing of a petition under 37 CFR § 1.137 would be moot.

PETITION GRANTED.

The application is being forwarded to the Technology Center 3700 technical support staff to place the application in a pending status to forward to the examiner for action on the amended brief.

Any inquiry regarding this decision should be directed to Allan N. Shoap, Special Programs Examiner, at (571) 272-4514.


Karen M. Young, Director
Technology Center 3700